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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,712	12/05/2001	Kazuo Hiraguchi	Q67023	7134

7590 03/04/2004

Sughrue Mion Zinn Macpeak & Seas
2100 Pennsylvania Avenue N W
Washington, DC 20037

EXAMINER

BUI, LUAN KIM

ART UNIT	PAPER NUMBER
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3728

15

DATE MAILED: 03/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/980,712

Applicant(s)

HIRAGUCHI ET AL.

Examiner

Luan K Bui

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8 is/are allowed.
- 6) ☒ Claim(s) 9-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 9-11 and 16 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Weisburn et al. (5,597,068; hereinafter Weisburn'068). Weisburn'068 discloses a storage case (1) comprising a storage part (2), a cover part (10) including outer walls for enclosing the storage part and a hinge part (11) for connecting together the storage part and the cover part in an openable and closable manner. The storage part is dimensioned to receive a jewel box (70). Weisburn'068 further discloses one or more ribs (40-47) with each having a U-shaped section disposed on the hinge part (Figures 1-8). The storage part of Weisburn'068 is inherently capable of holding a magnetic tape cassette and the ribs of Weisburn'068 are inherently capable of storing a sheet bundle therein. Regarding the intended use of the claimed invention for storing a magnetic tape cassette or capable of storing a sheet bundle, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. If the prior art structure is capable of performing the intended use, then it meets the claim. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 9-18 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Weisburn et al. (5,597,068; hereinafter Weisburn'068). Weisburn'068 discloses a storage case (1) comprising a storage part (2), a cover part (10) including outer walls and a hinge part (11) for connecting together the storage part and the cover part in an openable and closable manner. The storage part is dimensioned to receive a jewel box (70). Weisburn'068 further discloses one or more ribs (40-47) with each having a U-shaped section disposed on the hinge part (Figures 1-8). The ribs of Weisburn'068 are capable of storing a sheet bundle therein. To the extent that Weisburn'068 fails to show a clearance when the storage case is adapted for holding the magnetic tape cassette, it would have been obvious to one having ordinary skill in the art at the time the invention was made in view of Weisburn'068 to modify the storage case so the hinge part is made bigger having one or more ribs thereon to prevent the ribs from contacting the magnetic tape cassette.

Weisburn'068 fails to show the ribs comprise a pair of ribs as recited in claims 12-15 and 17. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the ribs of Weisburn'068 so the ribs comprises a pair of ribs each having two parallel flat plates having mutually opposed, convexly curved surfaces or the rib having a

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rectangular section and disposed substantially over the entire areas of the hinge part because the selection of the specific shape for the ribs such as the one as claimed would have been an obvious matter of design choice inasmuch as the resultant structures will work equally well and inasmuch as applicant's specification does not state that using these specific shapes as claimed solves any particular problem or yields any unexpected results.

5. Claim 18 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Cheng (5,443,159) in view of Weisburn et al. (5,597,068; hereinafter Weisburn'068). Cheng discloses a storage case for storing a magnetic tape cassette comprising a storage part (30), a cover part (10) and a hinge part (20) for connecting together the storage part and the cover part in an openable and closable manner. Cheng discloses the dimension of the hinge part is greater than a thickness of the magnetic tape cassette for defining a clearance between the cover part and the magnetic tape cassette and one or more ribs (21) disposed on the hinge part in a range of the clearance. Cheng fails to show the cover part comprises outer walls for enclosing the storage part. Weisburn'068 discloses a storage case (1) comprising a storage part (2), a cover part (10) including outer walls for enclosing the storage part and a hinge part (11) for connecting together the storage part and the cover part in an openable and closable manner. It would have been obvious to one having ordinary skill in the art in view of Weisburn'068 to modify the cover part of Cheng so the cover part includes outer walls for enclosing the storage part for better protecting the contents within the case.

Allowable Subject Matter

6. Claims 1-8 are allowed.

Response to Arguments

Applicant's arguments with respect to 1/15/2004 have been considered but are deemed to be moot in view of the new grounds of rejection.

Applicant's arguments with respect to the intended use such as "the magnetic tape" as recited in claim 9 are noted. They are not persuasive because the magnetic tape is not positively recited in the claim and applicant relied on such intended use to overcome the prior art as applied. If applicant believes "This is not the intended use but, instead, the specific arrangement of the features of the storage case", why such limitation is not positively recited in claim 9? If the magnetic tape cassette is positively recited in claim 9, then the rejection of claims 9-11 and 16 under 35 U.S.C. 102(b) will be withdrawn.

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

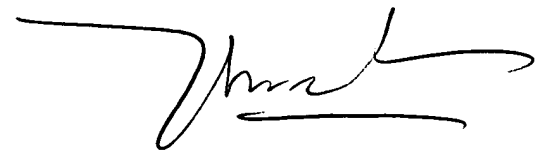
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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luan K. Bui whose telephone number is (703) 305-5861. If in receiving this Office Action, it is apparent to Applicant that certain documents are missing from the record for example copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to TC 3700 Customer Service at (703) 306-5648.

Any inquiry of a general nature or relating to the status of this application should be directed to the Customer Service whose telephone number is (703) 872-9301. Facsimile correspondence for this application should be sent to (703) 872-9306 for Formal papers and After Final communications.

lkb
March 2, 2004



Luan K. Bui
Primary Examiner